

REMARKS

The Applicants acknowledge the Examiner's comprehensive Office Action with appreciation. Claims 37-69 are pending in the application. The Office maintains the previously issued Restriction Requirement and makes it Final. The Office raises a rejection under 35 USC § 112, first paragraph. The Office also raises a rejection under 35 USC § 103. The Office acknowledges the Information Disclosure Statement (IDS) filed with the filing papers of the instant application as well as the IDS filed on April 23, 2007.

The Office acknowledges the priority claim to French Application FR 04.01690. The Office also indicates that the certified copy of the priority application was forwarded to the USPTO from the International Bureau in this US National Phase application. The Applicants respectfully submit that a certified copy of the priority application and a certified English translation thereof were filed with the filing papers of the instant application. Moreover, the priority document as well as the English translation are viewable in the Image File Wrapper (IFW) system at the USPTO website. Thus, the Applicants respectfully request that the Office acknowledge the perfected priority claim as well as receipt of the certified copy of the priority application and certified English translation thereof.

With respect to the Restriction Requirement, the Office acknowledges the election, ***with traverse***, of **Group I**; however, the Office maintains its position that **Groups I** and **II** do not relate to a single inventive concept because they lack a significant structural element which qualifies as a common special technical feature defining a contribution over the prior art. Thus, the Office states that the subject matter under consideration in the instant application is that subject matter encompassed by **Group I**, i.e., Claims 37-69 (in part)), drawn to compounds/compositions of formula (I) wherein the variables m, n, p, and q represent 1; the variables R₁-R₄ do **not** represent heteroaryl or heterocycloalkyl; the variables R₁-R₄ are **not** substituted by heteroaryl or heterocycloalkyl; and the variables R₁-R₂ and R₂-R₃ do not form heteroaryl or heterocycloalkyl, and their methods of use. The Office also requests that the claims be amended to cancel the non-elected subject matter. With the

instant Amendment, the claims have been amended to cancel the non-elected subject matter without prejudice to the prosecution of the cancelled subject matter in a Divisional application.

Claims 68-69 are rejected for lack of enablement under 35 USC § 112, first paragraph. It is the position of the Office that the specification, while being enabling for using compounds of formula (I) for increasing cerebral concentration of histamine in an animal model, does not reasonably provide enablement for using compounds of formula (I) for treating a condition selected from cognitive deficiencies associated with cerebral aging, mood disorders, Alzheimer's disease, Parkinson's disease, or Pick's disease in a human patient. The Office states that there is no established correlation between the data disclosed in the specification and treatment of the claimed conditions. The Office goes on to state that there is no description in the specification related to an actual method of treating the claimed conditions *in vivo* in a patient.

With respect to the scope of the claimed conditions, the Applicants note that instant Claim 68 is directed to treatment of "mood disorders" (among other conditions) and not to treatment of "cognitive deficiencies associated with mood disorders." With the instant Amendment, Claim 68 has been amended to clarify the scope of conditions claimed. Support for this Amendment may be found at page 2 of the specification, and the Applicants respectfully submit that no new matter has been introduced by the Amendment.

The Applicants respectfully submit that the instant specification discloses (citing several literature references) that it has been demonstrated that histamine plays a role in various physiological and behavioral processes and that, therefore, there are numerous potential therapeutic indications for compounds capable of increasing the turnover or release of histamine centrally. Moreover, according to MPEP § 2164.02, "An *in vitro* or *in vivo* animal model example in the specification, in effect, constitutes a 'working example' if that example 'correlates' with a disclosed or claimed method invention." MPEP § 2164.02 further states "...the issue of 'correlation is also dependent on the state of the prior art. In other words, if the art is such that a

particular model is recognized as correlating to a specific condition, then it should be accepted as correlating ***unless the examiner has evidence that the model does not correlate.***" (emphasis added)

Thus, the Applicants respectfully submit that the specification demonstrates that there is an art-recognized correlation between the data disclosed in the specification and treatment of the conditions claimed. Moreover, with the instant Response, the Applicants provide a Declaration by Dr. Pierre LESTAGE, a scientist skilled in this particular art, which speaks to the enablement rejection. Specifically, the Declarant provides pharmacological data for a representative compound of the instant invention which demonstrate that the instant compounds exhibit *in vivo* efficacy in art-recognized animal models related to neurodegenerative diseases and mood disorders. Moreover, the Declarant also provides a review of published literature which demonstrates that one skilled in the art would recognize that compounds which exhibit activity as H₃ antagonists have a definite and positive utility in the treatment of specific disease states, including cognitive deficiencies associated with cerebral aging and neurodegenerative diseases such as Alzheimer's disease, Parkinson's disease, Pick's disease, Korsakoff's disease, and frontal lobe and subcortical dementias of vascular or other origin as well as for the treatment of mood disorders and attention deficit hyperactivity syndrome.

The Applicants respectfully submit that treatment of the specific disease states recited in Claims 68 and 69 is supported by the instant specification as well as the LESTAGE Declaration and that, therefore, the instant invention is enabled with respect to the treatment of the specific conditions recited in Claims 68 and 69. Reconsideration and withdrawal of the enablement rejection under 35 USC § 112, first paragraph is respectfully requested.

Claims 37-69 are rejected for obviousness under 35 USC § 103(a) based on the disclosure of Svendsen, et al. (CAS Abstract No. 109:210691). It is the position of the Office that the specific compounds disclosed in the Svendsen, et al. abstract inherently overlap with the instantly claimed genus and that, therefore, the Svendsen, et al. disclosure renders the instantly claimed compounds obvious.

To begin, the Office has stated the invention under examination in the instant application is that invention defined by **Group I** of the previously issued Restriction Requirement. The Applicants respectfully submit that the nitrogen-containing ring system of the compounds disclosed in Svendsen, et al. is not encompassed by the genus defined by **Group I**. Moreover, in order for the instantly claimed genus to overlap with the compounds disclosed in Svendsen, et al., the instant W substituent would have to represent "alkyl"; however the definition for the instant "W" substituent does not include "alkyl" as an alternative. Thus, the Applicants respectfully submit that there is no basis for the Office allegation that the compounds disclosed in Svendsen, et al., which are distinguished for the two (2) differences discussed above, render the instantly claimed compounds obvious. Reconsideration and withdrawal of the obviousness rejection under 35 USC § 103(a) is respectfully requested.

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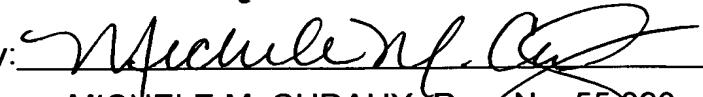
Accordingly, entry of the present amendment and the LESTAGE Declaration, reconsideration of all grounds of objection and rejection, withdrawal thereof, and passage of this application to issue are all hereby respectfully solicited.

It should be apparent that the undersigned agent has made an earnest effort to place this application into condition for immediate allowance. If she can be of assistance to the Examiner in the elimination of any possibly-outstanding insignificant impediment to an immediate allowance, the Examiner is respectfully invited to call her at her below-listed number for such purpose.

Allowance is solicited.

Respectfully submitted,

THE FIRM OF HUESCHEN AND SAGE

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Enclosure: Check No. 76941 for Two (2) Month Extension Fee; LESTAGE Declaration (Form PTO-1449 and accompanying references to follow under separate cover); Listing of Claims; and Postal Card Receipt

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THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY FURTHER OR ADDITIONAL FEES WHICH MAY BE REQUIRED (DUE TO OMISSION, DEFICIENCY, OR OTHERWISE), OR TO CREDIT ANY OVERPAYMENT, TO DEPOSIT ACCOUNT NO. 08,3220.